

### **REMARKS**

As may be appreciated from the above listing of claims, new claims 56-77 have been added to the application and the previously submitted claims have been cancelled. There are now 22 claims pending in the present application. Because an examination fee only covered the examination of 20 total and three independent claims, a fee for the examination of two additional claims is also provided herewith. Authorization is also provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

#### **I. THE PENDING CLAIMS ARE ALLOWABLE OVER THE CITED ART**

The Examiner rejected all the previously presented claims in view of U.S. Patent No. 6,356,541 to Muller et al., U.S. Patent No. 6,965,948 to Eneborg et al. or U.S. Patent No. 5,826,188 to Tayloe et al. in the Office Action dated June 8, 2009 (hereafter "the Office Action").

##### **A. Burden of Proving Anticipation Under 35 U.S.C. § 102**

"In order to demonstrate anticipation, the proponent must show that the four corners of a single, prior art document describe every element of the claimed invention." *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 88 U.S.P.Q.2d 1751, 1758, 2008 WL 4614511, \*8 (Fed. Cir. 2008). The prior art reference relied upon to show anticipation "must not only disclose all elements of the claim within the four corners of the document, but also disclose those elements arranged as in the claim." *Id.* "As arranged in the claim means that a reference that discloses all of the claimed ingredients, but not in the order claimed, would not anticipate because the reference would be missing any disclosure of the limitations of the claimed invention arranged as

in the claim." *Id.* "The test is thus more accurately understood to mean arranged or combined in the same way as in the claim." *Id.*

**B. Burden Of Proving Obviousness Under 35 U.S.C. § 103**

"All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, **all the limitations of the claims must be considered and given weight.**" MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, **there must be some**

**articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."** MPEP § 2143.01 (citing *KSR*, 550 U.S. at \_\_\_, 82 U.S.P.Q.2d at 1396) (emphasis added).

For instance, an invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge*, 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01.

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

**C. The Pending Claims Are Not Anticipated By Any Of The Cited Art**

**1. Claims 56-72 Are Not Anticipated By Any Of The Cited Art**

Claims 56-72 define a method that includes the steps of a telecommunication terminal device analyzing saved quality of service information for at least one first network to select access to at least one of a plurality of second networks to connect to that at least one second network and the telecommunication terminal device selecting access to the at least one second network of the plurality of second networks.

The cited art does not teach or suggest such limitations. For example, Eneborg et al. disclose a device configured to obtain network quality of service information from network access devices to compare this information and determine which network to select for accessing

that network. (*See* Col. 7, line 40 through Col. 8, line 53). There is no teaching or suggestion of saving any quality of service information by the telecommunication terminal device after it is connected to a network for using after that device disconnects with that network. For instance, there is no teaching or suggestion by Eneborg et al. for using saved network quality of service information in subsequent determinations of which network to select. To the contrary, Eneborg et al. teach that telecommunication terminal devices should be configured to get all the information needed for selecting a network from network terminating devices such as network terminating device 350. (*See* Col. 7, line 40 through Col. 8, line 53).

Tayloe et al. and Muller et al. also fail to teach or suggest a telecommunication terminal device saving network quality of service information for use in subsequent selections of networks to access. None of the cited art discloses all the limitations of claims 56-72. Therefore, none of the cited art can anticipate any of the pending claims.

## **2. Claims 73-77 Are Not Anticipated By Any Of The Cited Art**

Claim 73 requires a telecommunication terminal device to include a reputation repository module connected to a monitor module. The reputation repository module is configured to retain quality of network connection information monitored by the monitor module. The telecommunication terminal device also includes a connection analysis module connected to the reputation repository module. The connection analysis module is configured to analyze network connection information retained in the reputation repository module. The telecommunication terminal device also includes a connection management module connected to the connection analysis module. The connection management module is configured to use data analyzed in the connection analysis module to determine an accessible network to select for connection to a

network. Claims 74-77 depend directly or indirectly from claim 73 and therefore also contain these limitations.

None of the cited art teaches or suggests a telecommunication terminal device that includes a reputation repository module, connection analysis module and connection management module as required by claims 73-77. For instance, Eneborg et al. does not disclose any module or other feature of a telecommunication terminal device configured to save quality of network connection information. Nor do Eneborg et al. teach or suggest any module or other feature of a telecommunication terminal device configured to analyze accessible networks based on quality of network connection information saved on that telecommunication terminal device. As discussed above with reference to claims 56-72, the device disclosed by Eneborg et al. only obtains information from network terminating devices for use in comparing received information to select a network to access. Indeed, Eneborg et al. do not teach or suggestion any saving or recording of network quality of service information after a network is selected.

Tayloe et al. and Muller et al. also fail to teach or suggest a telecommunication terminal device saving network quality of service information. Nor do Tayloe et al. or Muller et al. disclose a telecommunication terminal device configured to use or analyze such stored information in subsequent selections of networks to access. None of the cited art discloses all the limitations of claims 73-77. Therefore, none of the cited art can anticipate any of the pending claims

**D. The Pending Claims Are Not Rendered Obvious By The Cited Art**

As discussed above, none of the cited art teaches or suggests a telecommunication terminal device saving network quality of service information or a telecommunication terminal

device configured to use or analyze such stored information in subsequent selections of networks to access. Any combination of the cited art also fails to teach or suggest such limitations.

Therefore, none of the cited art can render any of claims 56-77 obvious.

**2. Claims 58-58 Are Allowable**

Claim 58 requires the method of claim 56 to also include determining a location of the telecommunication terminal device when the telecommunication terminal device is connected to the at least one first network and linking location information of the telecommunication terminal device to the recorded and saved quality of service information for the at least one first network. Claim 59 depends from claim 58 and therefore also contains these limitations. None of the cited art teaches or suggests the determining of a telecommunication terminal device location and linking of that location to saved quality of service information. Therefore, the combination of cited art cannot render these claims obvious.

**3. Claims 60-61 Are Allowable**

Claim 60 requires the method defined in claim 56 to also include the telecommunication terminal device communicating with at least one other telecommunication terminal device to obtain quality of service information for at least one of the plurality of second networks for use in determining which of the at least one second networks to select. Claim 61 depends from claim 60 and requires that the one or more other telecommunication terminal device be within a predetermined distance of the telecommunication terminal device.

None of the cited art teaches or suggests a telecommunication terminal device obtain quality of service information for any network that is saved on another telecommunication terminal device for use in determining a network to select. Moreover, none of the cited art

teaches or suggests that these other telecommunication terminal devices be within a predetermined distance of the telecommunication terminal device. Therefore, the combination of cited art cannot render claims 60-61 obvious.

**E.      The Pending Claims Have Eliminated The Need For Obtaining Network Quality Of Service Information From A Network Terminating Device**

The device and method of the pending claims permit telecommunication terminal devices to not have to obtain quality of service information from network access devices or network terminating devices in order to determine which network to select for accessing. The elimination of such a requirement is an indicia of obviousness and shows that the pending claims are allowable. *In re Edge*, 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04.

**F.      Granted European Patent No. EP 1 557 002 Shows The Pending Claims Are Allowable**

The present application corresponds to granted European Patent No. EP 1 557 002. For the Examiner's reference, a copy of this patent is provided herewith. The European Patent Office has found the invention disclosed in the present application to warrant patent protection. This is an indicia of the non-obvious nature of the pending claims and shows that the claims should be allowed.

## **II. CONCLUSION**

For at least the above reasons, reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

/Ralph G. Fischer/

Dated: September 8, 2009

Ralph G. Fischer  
Registration No. 55,179  
BUCHANAN INGERSOLL & ROONEY PC  
One Oxford Centre  
301 Grant Street  
Pittsburgh, Pennsylvania 15219

(412) 392-2121

Attorney for Applicant